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Attorney's Docket No.: 15786-042001

### REMARKS

This Amendment is in response to the Office Action mailed October 1, 2004. Claims 1-43 are pending. Claims 19 and 41 have been objected to, but are otherwise allowable. The remaining claims have been rejected.

Claim 1 has been amended in this response

#### Rejections under 35 U.S.C. § 102 over Dolphin

Claims 1-2, 4-7, 11, 13, 16, 18, 20, 23-27, and 29-31 stand rejected under 35 U.S.C. § 102(b) over U.S. Patent 5,703,951 to Dolphin ("Dolphin"). Claim 1 is the single independent claim of this group. Claim 1 recites a method of distributing authorization keys that are each associated with a validity period during which the key will be valid, and distributing new authorization keys at intermittent times. Each authorization key allows an application program to be operated during the validity period. In addition, the keys are distributed electronically in a manner that is transparent to users of the computers.

In this manner, claim 1 provides for a method whereby a company may distribute its software programs in new and flexible ways, and yet control access to the programs, without interfering with the user's use of the programs. By this approach, software need not simply be sold in a box off a shelf for indefinite use—an approach that often results in software that is prohibitively expensive and inflexible because customers do not always need indefinite use, or do not want to use the exact same piece of software indefinitely. Instead, users or companies can purchase use of software in increments that work for them, can do so for multiple users within a company, and can do so without problematic interference in the users' use of the programs.

The approach discussed in Dolphin relates to an entirely different area and also lacks unique features recited in claim 1. Specifically, Dolphin discusses a system for providing access to written material, such as magazines distributed on CD-ROM disks. While Dolphin may follow the classic subscription model for such reading materials, it does nothing to disclose or suggest a system in which users are to be provided access to *application programs* for certain intermittent validity periods.

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Moreover, the Dolphin system is limited and intrusive. It is limited because Dolphin says nothing about intermittent distribution of new keys having new validity periods. Rather as shown in Figures 8 and 9, a publisher simply establishes a start and expiration date for a single key (or provides some other usage limitation for the key). *See also* Dolphin, col. 4, lines 39-52 (noting steps a user takes to receive a "particular access code" for material on a CD-ROM); col. 7, lines 22-29 (discussing a "zeroization" feature that blocks access to material when the key expires); col. 8, lines 8-24 (discussing the need for a user to select a payment mode to receive a key). Nothing in Dolphin discloses or suggests the intermittent transfer of different keys, even if one were to assume improperly that Dolphin discloses use of keys to access application programs. The Office Action points to Figures 1 and 8 of Dolphin for these features, but those figures simply show, respectively, the layout of the Dolphin system for providing one authorization key for each group of content, and a screen display for a publisher who wants to set attributes for a particular key. Thus, Dolphin in no way teaches or suggests a system by which access to an application program may be provided over a number of separate validity periods—a feature that allows for the types of benefits discussed above. For this reason alone, the Applicants respectfully submit that the claims are in condition for allowance.

The Dolphin system is also intrusive in that the manner in which keys are distributed in that system is not transparent to the user, as is recited in pending claim 1. In fact, Dolphin requires the user to create a purchase request and send it, e.g., via e-mail, to a billing/access center and then to select a form of payment. *See, e.g.*, Dolphin, col. 7, line 49 to col. 8, line 24; col. 8, line 30-32. This process is initiated by the user and requires full involvement by the user; where the user is so fully involved, the process is not transparent to the user. Thus, for this reason too Dolphin cannot anticipate claim 1 or the claims that depend on it, and the Applicants request allowance of those claims.

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Rejections under 35 U.S.C. § 103 over Dolphin

Claims 3, 10, 12, 14-15, 17, 21-22, 28, 32-40, and 42-43 stand rejected under 35 U.S.C. § 103 over Dolphin. Claims 32 and 43 are the independent claims in this group. The other claims depend on one of these claims or on claim 1.

Claim 1 is discussed above, as are the failures by Dolphin to teach or suggest the features recited in claim 1, so that Applicants respectfully suggest that all of the claims that depend on claim 1 are patentable. The dependent claims are patentable for other reasons also. As to claims 3 and 17, the Office Action takes "official notice" but provides no evidence whatsoever for that official notice. Such a practice cannot, as a matter of law, make out a *prima facie* case for obviousness. *See In re Lee*, 277 F.3d 1338 (Fed. Cir. 2002) (reversing rejection where Board referred to "common knowledge and common sense of a person of ordinary skill" but provided no supporting evidence). Moreover, even if distribution of a new key at the end of a validity period were well known, the Office Action does not indicate that its use in the manner recited in claim 1 is well known or even that there is any motivation in the art to use it in the way recited in the pending claims, so again the Office Action does not make out a *prima facie* case of obviousness. The rejection of claims 10, 12, 14, 15, and 21 suffers from the same problem, and also does not make out a *prima facie* case, as the Office is required to do. The same problems attend to the rejection of claim 28, and more specifically, although demonstration modes may be common in other contexts, the Office Action does nothing to suggest that the prior art discloses remote authorization using multiple keys having validity periods and whose acquisition occurs in a manner that is transparent to the user.

As to claims 32 and 43, the passage from Dolphin cited in the Office Action simply indicates that certain information on a CD-ROM (one would presume that such information would be instructions regarding how to use the CD-ROM) would not be encrypted, while other information (such as the substantive reading material) would be encrypted. Again, and as noted above, nothing in Dolphin teaches or suggests distribution of an application program as recited in claim 32 or receiving information at a server about users who are authorized to use copies of an application program. Nothing teaches multiple modes for running an application program, with

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the user given the choice to choose from the modes as recited in claim 32. Also, claim 43 recites the feature of matching a user identity with information at a server identifying individual users; Dolphin simply receives a purchase request and provides an authorization key, but there is no indication or teaching that the billing/access center of Dolphin would or should have identifying information to which a user identity needs to be matched. In other words, Dolphin receives a request for a key and provides it, but does not make sure that the user associated with the request matches anything. The Office Action also refers to a motivation to avoid hackers, yet Applicants cannot understand why or how someone would "hack" magazine or other reading information. Thus, the mention of hackers appears to be a concern generated by using the Applicants' disclosed invention in an improper hindsight reconstruction. Thus, for these reasons also, Applicants respectfully suggest that claims 32 and 43 are in condition for allowance.

As to claims 33-37, they are patentable as dependent on claim 32, and also for the reasons stated for claim 28 above. Claim 38 is patentable as dependent on claim 32. Claim 39 is patentable as dependent on claim 32 and because Dolphin does not teach or suggest a TCP-IP communication. Claims 40 and 42 are also patentable as dependent on claim 32.

Rejections under 35 U.S.C. § 103 over Dolphin in view of Brandt

Claims 8 and 9 stand rejected under 35 U.S.C. § 103 over Dolphin in view of U.S. Patent 5,758,068 to Brandt et al. ("Brandt"). These claims depend on claim 1 and also recite the automatic provision of a grace period when a validity period lapses.

As an initial matter, these claims are patentable for the reasons discussed above for claim 1. In addition, the Office Action simply concludes that the claims would have been obvious in light of Dolphin and Brandt, but does not identify any motivation in either reference or anywhere else to combine the references, as is required by the law. As a result, Applicants respectfully submit that claims 8 and 9 are also in condition for immediate allowance.

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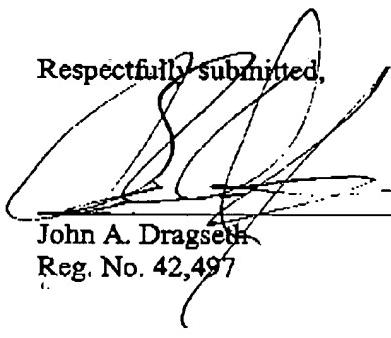
Objections to claims 19 and 41

The Office Action objects to claims 19 and 41, but indicates that they would be allowable if rewritten in independent form. For the reasons discussed above, Applicants respectfully suggest that the claims on which claims 19 and 41 depend are separately patentable.

Please apply any charges or credits to deposit account 06-1050.

Date: 2-1-05

Respectfully submitted,

  
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